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| 10/721,552 | 11/25/2003 | Jean-Louis Gueret | NONY 3.0-015 | 5845 |
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| LERNER, DAVID, LITTENBERG, KRUMHOLZ & MENTLIK 600 SOUTH AVENUE WEST WESTFIELD, NJ 07090 | | | STETIZ, RACHEL RUNNING | |
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

| | | |
|------------------------------|--------------------------------------|---|
| Office Action Summary | Application No. 10/721,552 | Applicant(s) GUERET, JEAN-Louis |
| | Examiner RACHEL R. STEITZ | Art Unit 3732 |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If no period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).

Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) Responsive to communication(s) filed on 22 October 2009.

2a) This action is FINAL. 2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4) Claim(s) 1-32 and 34-36 is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5) Claim(s) _____ is/are allowed.

6) Claim(s) 1, 3-32, 34-36 is/are rejected.

7) Claim(s) _____ is/are objected to.

8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) Notice of References Cited (PTO-892)
 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)
 3) Information Disclosure Statement(s) (PTO/GS-68)
 Paper No(s)/Mail Date _____

4) Interview Summary (PTO-413)
 Paper No(s)/Mail Date _____

5) Notice of Informal Patent Application
 6) Other: _____

DETAILED ACTION

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1, 3-26, 29-32, 34, and 35 are rejected under 35 U.S.C. 103(a) as being unpatentable over Anakama (Japanese Patent No. 55-136409) in view of Gueret (US 5,918,994) and Anderson (US 3,343,551).

Anakama discloses a device comprising a rod 2 having a brush 3 affixed to one end with a core and bristle carrying portion. The bristle carrying portion forms an angle of greater than zero degrees relative to the longitudinal axis of the rod. The device further includes a receptacle adapted to receive the rod and brush. As noted in the claims the brush is "slightly tilted" and thus only encompassing a small angle will not touch the inner wall of the receptacle when in the assembled condition, further Anakama discloses that the applicator bristles can be brought out smoothly, without dragging or catching on anything at all. Anakama discloses the claimed invention except for the brush comprising a twisted wire core and the specific angle the bristle carrying portion makes relative to the longitudinal axis of the rod.

Gueret '994 discloses that it is old and well known in the art to make mascara brushes with a twisted wire core. Gueret '994 further discloses various mascara brushes

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having non-circular cross sections; longitudinal ribs; plane surfaces; concave surfaces; constant cross sections; varying cross sections; and cross sections that vary in size, and having an envelope surface having a non-circular cross-section at least one point along the bristle carrying portion. Because both Anakama and Gueret '994 disclose application brushes , it would have been obvious to one skilled in the art to substitute the twisted wire core brush of Gueret '994 for the brush of Anakama in order to achieve the predictable result of manufacturing an applicator brush (*KSR International v. Teleflex Inc.*, 82 USPQ2d 1385 (2007)).

Further Anakama discloses that the angle is around 30 degrees. Anderson teaches a mascara application device that teaches an angle from 0 to 60 degrees. It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the angle of Anakama to be at a range from 0 to 60 degrees in order to accommodate different users. Further it would have been further obvious to one having ordinary skill in the art at the time the invention was made to have the bristle carrying portion make an angle of less than 20 degrees relative to the longitudinal axis of the rod, since it has been held that where the general conditions of a claim are disclosed in the prior art, discovering the optimum or workable ranges involves only routine skill in the art. *In re Aller*, 105 USPQ 233.

Regarding claims 2-4, 12-15, 19-26, it would have been obvious to one skilled in the art to form the brush of Anakama with the bristles forming an envelope having non-circular cross sections; longitudinal ribs; plane surfaces; concave surfaces; constant cross sections; varying cross sections; and cross sections that vary in size, but not

shape in view of Gueret '994 in order to obtain a make-up which is full-bodied, regular, elongated and curly.

Regarding claims 16-18, it would have been obvious to one of ordinary skill to make the core of twisted wire having either a right or left hand pitch, as it is old and well known in the art to make mascara brushes with a twisted wire core having either a right or left hand pitch.

Regarding claim 35, it appears as thought the wiper member would have a circular cross-section since the rod has a circular-cross section, however, it would have been an obvious matter of design choice to have the wiper be of a circular-cross since applicant has not disclosed that the wiper of any other cross-section solves any stated problem or is for any particular purpose and it appears that the invention would perform equally well with any cross-sectional wiper.

3. Claims 27, 28, and 36 are rejected under 35 U.S.C. 103(a) as being unpatentable over Anakama (Japanese Patent No. 55-136409) in view of Gueret (US 5,918,994), Anderson (US 3,343,551), and Gueret (US 5,462,798).

Anakama discloses a device comprising a rod 2 having a brush 3 affixed to one end with a core and bristle carrying portion. The bristle carrying portion forms an angle of greater than zero degrees relative to the longitudinal axis of the rod. The device further includes a receptacle adapted to receive the rod and brush. As noted in the claims the brush is "slightly tilted" and thus only encompassing a small angle will not touch the inner wall of the receptacle when in the assembled condition, further Anakama discloses that the applicator bristles can be brought out smoothly, without

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dragging or catching on anything at all. Anakama discloses the claimed invention except for the brush comprising a twisted wire core and the specific angle the bristle carrying portion makes relative to the longitudinal axis of the rod.

Gueret '798 discloses that it is old and well known in the art to make mascara brushes with a twisted wire core. Gueret '798 further discloses various mascara brushes having non-circular cross sections; longitudinal ribs; plane surfaces; concave surfaces; constant cross sections; varying cross sections; and cross sections that vary in size, and having an envelope surface having a non-circular cross-section at least one point along the bristle carrying portion. Because both Anakama and Gueret '798 disclose application brushes, it would have been obvious to one skilled in the art to substitute the twisted wire core brush of Gueret '798 for the brush of Anakama in order to achieve the predictable result of manufacturing an applicator brush (*KSR International v. Teleflex Inc.*, 82 USPQ2d 1385 (2007)).

Further Anakama discloses that the angle is around 30 degrees. Anderson teaches a mascara application device that teaches an angle from 0 to 60 degrees. It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the angle of Anakama to be at a range from 0 to 60 degrees in order to accommodate different users. Further it would have been further obvious to one having ordinary skill in the art at the time the invention was made to have the bristle carrying portion be made at an angle of greater than 5 degrees and less than about 10 degrees relative to the longitudinal axis of the rod, since it has been held that where the

general conditions of a claim are disclosed in the prior art, discovering the optimum or workable ranges involves only routine skill in the art. In re Aller, 105 USPQ 233.

Anakama does not disclose a compound configured to cause a modification to sliding resistance of the bristles. Gueret '798 teaches compound configured to cause a modification to sliding resistance of the bristles (column 2, Example 1). It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the bristles of Anakama with a sliding component as taught by Gueret '798 in order to provide a sliding resistance to the bristles.

Response to Arguments

4. Applicant's arguments filed October 22, 2009 have been fully considered but they are not persuasive.
5. In response to applicant's argument that the art does not suggest in any way that the angle of the bristles relative to the rod is a result effective variable for the amount of material retained on the bristles, however, Anderson teaches the range of 0 degrees to about 60 degrees with respect to the bristle carrying portion and the rod, therefore, one having ordinary skill in the art would be able to optimize those values to determine the parameter.
6. In response to applicant's argument that neither Anakama, Gueret '994 nor Anderson disclose the brush being spaced from the inner wall, however, Anakama teaches that the bristles can be "brought out smoothly, without dragging or catching on

anything at all" in order for the bristles of Anakama to be brought out without dragging on the wall they must be spaced from the wall, and hence meeting the claim limitation.

7. In response to applicant's argument that Anakama teaches away from the wiper feature, however, the claims merely states a wiper member "configured to contact said brush during withdrawal of said brush from said receptacle" if Anakama's brush is turned so that the angle is near the shorter part of the oval opening the bristles would be "capable" of coming into contact with the wiper as claimed.

8. In response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

9. In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, the motivation to

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combine comes from both Anakama and Anderson who both teach having angled bristle portions to accommodate the users.

10. In response to applicant's argument that Anderson's brush with a larger angle cannot be used with conventional container, however, it is unclear as to what evidence there is that proves Anderson's brush can not be used with a conventional container other than the fact that applicant merely states that this can not be done.

Conclusion

11. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to RACHEL R. STEITZ whose telephone number is

(571)272-1917. The examiner can normally be reached on Monday-Friday 9:00 am - 5:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Cris Rodriguez can be reached on (571) 272-4964. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Rachel Running Steitz/
Examiner
Art Unit 3732

2/3/2010

/Cris L. Rodriguez/
Supervisory Patent Examiner, Art Unit 3732